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| 10/713,088      | 11/17/2003  | Kia Silverbrook      | ZG175US             | 9625             |

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BALMAIN, 2041  
AUSTRALIA

EXAMINER

GORDON, RAQUEL YVETTE

ART UNIT PAPER NUMBER

2853

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/713,088

Applicant(s)

SILVERBROOK, KIA

Examiner

Raquel Y. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on application filed 11/17/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-17 and 19 is/are rejected.
- 7) ☒ Claim(s) 12 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/17/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, the following terms lack antecedent basis: "the openings" (claim 1); "the same" (claim 3, claim 12 (two occurrences), and claim 14).

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***Double Patenting Statutory Basis***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

***Double Patenting Rejection***

Claims 1-19 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 10/713067. This is a

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provisional double patenting rejection since the conflicting claims have not in fact been patented.

For example, the following claim limitations are in jeopardy of being double patented:

1. A core for a printhead assembly, the core comprising: an extruded and elongated body having a plurality of interior reservoirs, the reservoirs each having an ink exit opening, the openings converging into an area adapted to receive a printhead which is bonded to the area (claim 9/1);
2. A core according to claim 1, wherein: the body is a plastic extrusion (claim 10/1);
3. A core according to claim 1, wherein: the body is adapted to be at least partially encased by a shell (claim 11/1), the body and shell when joined, having a coefficient of thermal expansion substantially the same as the printhead which the body is adapted to receive (claim 12/11/1);
4. A core according to claim 3, wherein: the body includes a portion which protrudes beyond the shell, this portion receiving the printhead (claim 12/11/1);
5. A core according to claim 1, wherein: the body is internally subdivided by extruded membranes to define the reservoirs (claim 13);

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6. A core according to claim 1, wherein: the reservoirs are four in number (claim 14);

7. A core according to claim 3, wherein: the core and the shell have coefficients of expansion which are different than the coefficient of expansion of silicon, one of them having a coefficient of expansion which is greater than the coefficient of expansion of silicon and one of them having a coefficient of expansion which is less than the coefficient of expansion of silicon (claims 15/1 and 16/1);

8. A core according to claim 1, further comprising: a modular pagewidth printhead comprising a plurality of silicon modules disposed along the length of the core (claim 18/1);

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9. A core according to claim 8, wherein: each module is fabricated from silicon (claim 19/18/1);

10. A core according to claim 9, wherein: each module further comprises ink nozzles, chambers or actuators (claim 13/10/1);

11. A core according to claim 1, further comprising: a shell, the shell being a longitudinal laminated structure defining an interior space, formed from layers of at least two materials; the layers being odd in number and disposed symmetrically about a central layer (4/1);

13. A device according to claim 11, wherein: the shell further comprises a longitudinal gap adapted to receive a component of the printhead ("area adapted to receive," as recited in claim 7);

14. A device according to claim 11, wherein: the laminated shell is formed from at least three metals laminated together, the laminate having inner and outer layers which have the same coefficient of thermal expansion (claim 2/1);

15. A device according to claim 11, wherein: the shell has outer layers which are made from invar (claim 8/2/1);

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16. A device according to claim 11, wherein: each different material has a different coefficient of thermal expansion (claim 6/4/1);

17. A device according to claim 16, wherein: at least two materials have coefficients of expansion which are different than the coefficient of expansion of silicon, one material having a coefficient of expansion which is greater than the coefficient of expansion of silicon and one material having a coefficient of expansion which is less than the coefficient of expansion of silicon (claim 16/1);

19. A device according to claim 11, wherein: all of the layers are metal (claim 2/1).

***Allowable Subject Matter***

Claims 12 and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Reasons for Indication of Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter: The following claim limitations are not taught by the prior art:

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12. A device according to claim 11, wherein: two layers which are symmetrically disposed about the central layer are made from the same material and have the same thickness;

18. A device according to claim 11, wherein: two layers which are symmetrically disposed about the central layer have different thicknesses, the lateral cross section of the shell, in compensation, being configured to prevent bowing.

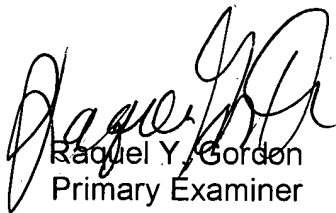
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**Contact Information**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Raquel Y. Gordon, whose telephone number is (571) 272-2145. The Examiner can normally be reached on M Tu Th and F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. A fax number is available upon request.

Any inquiry of a general nature or relating to the status of this application or proceeding may be directed to the Examiner or Supervisor.



Raquel Y. Gordon  
Primary Examiner  
Art Unit 2853  
May 26, 2004

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**RAQUEL GORDON  
PRIMARY EXAMINER**